

Remarks/Arguments

Claims 37-55 are pending in this Application. In the Office Action mailed September 1, 2005, the Examiner, *inter alia*, rejected Claims 37-55 under 35 U.S.C. §103(a) as being unpatentable over Benefiel (U.S. Patent No. 5,100,732). Applicants respectfully address the rejection below and introduce new Claims 56-62, claims believed necessary to adequately protect Applicants' invention. Applicants also thank the Examiner for participating in a telephone interview in October, in which the Examiner reviewed with the Applicants the reasons for rejecting Claims 37-55 over Benefiel and further stated that to overcome the prior art, the invention should show an improvement over the art of record.

Claims Rejection under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 37-55 under §103(a) as being unpatentable over Benefiel. The Examiner further states:

Benefiel produced coiled metal stock having a 'high tech' finish described as having improved depth, gloss, distinctness of image, chromaticity and durability. Clearly, a glossy finish, as suggested by Benefiel, must have reflective properties of some extent or it would not be glossy. Furthermore, Applicant has no disclosure of using coating materials other than those suggested by Benefiel; i.e., polyesters, acrylics and fluoropolymers. Thus, Applicants use of the term 'reflective' is not considered to distinguish over the 'glossy' materials suggested by Benefiel. Additionally, it appears that the crux of the invention is the production of completely coated stock material which may be coiled for storage and subsequently shaped into an end product, thus avoiding the more cumbersome procedure of applying the coating after formation of the product. This is exactly the problem addressed by Benefiel. See column 2, lines 60 to 69. One skilled in the art would be able to select particular coating materials to optimize desired characteristics in any end product intended to be formed from the coated stock following the teaching of Benefiel.

Applicants respectfully disagrees with the Examiner statements. For example, Applicants point out that Benefiel does not disclose or suggest disposing only a first and second reflective materials on a substrate, rolling the substrate into a coil or providing a channel letter coil. Rather, Benefiel discloses a coated substrate for automobiles and trucks and a method for coating such a substrate, in which the substrate (50) is defined as having a metal veneer (60), the metal veneer further consisting of a metal substrate (70), primer coating (80), pigmented basecoat (90), clear topcoat (100) and protective coating (110) as described and shown in Fig. 3. Further, the substrate having a metal veneer is not coiled after processing; it is the metal veneer that may be coiled after processing (Col. 5, ll. 7-16). If the Examiner is referring to the metal veneer as being equivalent to

Applicants invention, then Applicants respectfully point out that Benefiel also does not disclose or suggest the metal veneer having only a first and second reflective material or that the metal veneer provides a channel letter coil. Applicants respectfully request the Examiner to provide support for this in Benefiel, if it exists. Further, regarding the statement, "One skilled in the art would be able to select particular coating materials to optimize desired characteristics in any end product intended to be formed from the coated stock following the teaching of Benefiel," Applicants, with all due respect, request the Examiner to provide specific support for such a statement (or an Affidavit). With regard to the process for coating described by Benefiel, Applicants respectfully point out that Benefiel discloses a method of coating a substrate in which the process begins with a metal (presumed to be the substrate) which is treated as follows: (a) first treated with surface protective chemicals (Col. 4, ll. 25-26); (b) after which a primer coating is applied (Col 4, ll. 30-36); (c) followed by addition of a pigmented basecoat (Col. 4, ll. 40-45); (d) addition of a clear outer coat (Col 4, ll. 53-55) and (e) finally addition of a protective coating (Col. 5, ll. 3-7). Importantly, Benefiel teaches that those skilled in the art understand that the use of terms such as topcoat and basecoat are not generally a single coat but each includes multiple coats, see for example Col. 4, ll. 65-6, where Benefiel states, "the topcoat can consist of pigmented topcoat, a pigmented inner basecoat, and clear outer topcoat, a clear topcoat, or multilayer coatings such as those disclosed in U.S. Pat. Nos. 4,753,829, 4,615,940, and 4,598,020 which are incorporated herein by reference." With this in mind, Applicants respectfully submit amended Claims 37-41, 44, 47-49, 51 and 53 to 55. Amended Claim 37, from which all other claims depend, has been amended to include "providing a substrate having a first and second surface; disposing a first material upon the first surface of the substrate, wherein the first material has a reflective surface; disposing a second material upon the first material, wherein the second material has a reflective surface, and wherein no additional material is required to provide a highly reflective surface to the substrate; and rolling the substrate into a coil, thereby providing a finished channel letter coil." (Emphasis added to show amended text) Applicants respectfully point out that Benefiel does not disclose disposing a first and second material on a substrate, wherein the first and second materials each have a reflective surface and no additional material is required to provide a highly reflective surface to the substrate followed by rolling the substrate into a coil thereby providing a finished channel letter coil. Applicants refer to the discussion provided above and respectfully submit that because Benefiel does not describe or suggest each and every element of Applicants' claimed invention or the claimed invention on its whole that Benefiel fails to render

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Reply to FINAL Office Action dated September 1, 2005

amended Claim 37 obvious. There is also no suggestion or motivation in the Benefiel reference itself to prompt one of ordinary skill to selectively combine and seek out all elements as required by amended Claim 37. Accordingly, Applicants respectfully submit that amended Claim 37 is patentably distinguishable over the art cited and request allowance of amended Claim 37. Support for amended Claim 37 may be found throughout the specification, for example, see paragraph [0022].

Claims 38-41, 44, 47-49, 51 and 53 to 55 have been amended as to matters of form and to provide proper antecedent basis where appropriate. No new matter has been added with such amendments. Because these amended claims as well as Claims 42-43, 45-46, 50 and 52 depend from amended Claim 37 which is believed to be patentably distinct over the cited art, all claims depending from amended Claim 37 are believed to be in allowable form. Reconsidered and allowance of such claims is respectfully requested.

Claims 1-36 have been canceled pursuant to filing of a continuing application. New Claims 56-62 have been added with this Amendment to provide necessary protection of Applicants' invention. Support for the new claims may be found throughout the specification, for example, see paragraphs [0019] and [0022]. Applicants submit that new Claims 56-62 do not introduce new matter and are patentably distinct over the cited art. Accordingly, Applicants respectfully request allowance of new Claims 56-62.

Conclusion

Consideration for and allowance of the pending and new claims in this Application, as provided in the Listing of Claims beginning on page three of this paper and pursuant to the filing of this Amendment and a Request for Continued Examination (RCE), are respectfully requested for the reasons set forth herein. In light of the amendments, remarks and arguments presented with this Amendment, Applicants respectfully submit that the pending, amended and new claims are in condition for allowance. No new matter has been introduced with this Amendment. Favorable consideration for and allowance of Claims 37-62 are, therefore, respectfully requested.

Fees for filing a Request for Continued Examination and the new claims are provided; no additional fees are believed due with this response. If this is incorrect, the Commissioner is authorized to charge the additional fees, other than the issue fee, that may be required by this paper to Deposit Account No. 07-0153.

If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.

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Respectfully submitted,
GARDERE WYNNE SEWELL LLP

Monique A. Vander Molen
Monique A. Vander Molen
Registration No. 53,716
AGENT FOR APPLICANTS

1601 Elm Street, Suite 3000
Dallas, Texas 75201-4761
(214) 999-3000 – Telephone
(214) 999-3623 – Facsimile